

REMARKS

Claims 1-10, 12-14, 19-21, 23, 25, 29-30, 51, 56, 58, 62, 67-68, 70, 110, 121-122 and 139-140 have been amended; claims 63-66 and 71-98 have been canceled; new claims 141-183 have been added. Claims 1-62, 67-70, 99-133, and 136-183 are now pending in this application.

Response to Restriction Requirement

Applicant has reviewed the Restriction Requirement mailed July 22, 2005, wherein the Examiner has restricted the claims to one of the following inventions under 35 U.S.C. 121:

Group I: Claims 1-31, 35-74, 76-83, 87-98, 121, 122, 127-133, and 137-139, drawn to a composition; and

Group II: Claims 32-34, 84-86, 99-120, 123-126, 136, and 140, drawn to a coated substrate.

I. Response to Election/Restriction

Applicant hereby elects, with traverse, Group I (claims 1-31, 35-74, 76-83, 87-98, 121, 122, 127-133, and 137-139). Applicant requests that the amended claims listed above and new claims 141-183 be examined with Group I. Applicant has canceled claims 63-66 and 71-98.

If the restriction is continued, the claims of the non-elected invention, claims 32-34, 84-86, 99-120, 123-126, 136, and 140 (Group II) will be canceled without prejudice or disclaimer. However, Applicant reserves the right to reintroduce them in one or more continuation or divisional applications at a later date.

A. Groups I and II are Properly Examined Together.

The Restriction Requirement is traversed on the basis that restriction requirements are optional in all cases. MPEP §803. If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it arguably may include claims to distinct or independent inventions MPEP §803. In the present application, since the elected claims (Group I) are closely related to the claims in Group II, it is respectfully submitted that the claims of Groups I and II can be efficiently and effectively searched in a single search with no additional burden placed on the Examiner.

In fact, the Examiner has already performed such a search in the parent application, i.e., U.S. Patent Application No. 10/346,374. Both substrate claims and claims directed to a method for coating a substrate were searched and examined in '374. Although no claims directed to a coating system were present in '374, Applicant respectfully submits that such claims should also be examined at the same time. Applicant urges the Examiner to search and examine all the pending claims in a single prosecution.

B. A Combined Search and Examination can be Made without Serious Burden.

The MPEP also states, in section 803, that not only must the inventions be independent, there must also be a serious burden on the Examiner. However, in this instance, the scope of the search should not vary regardless of which sets of claims are examined. Thus, there is no hardship on the part of the Examiner in performing the search and dealing with all the claims in the prosecution of one application.

II. Provisional Election of Species

Applicant also provisionally elects, with traverse, in "Species Group I", as identified in the Restriction Requirement, "mixed oxides" in claim 2. Applicant also provisionally elects, with traverse, in "Species Group II," as identified in the Restriction Requirement, "linear and cyclic dextrins" in claim 21, "gelatin" in claim 23, "arginine" in claim 26. Applicant has canceled claims 79 and 92, therefore no species selection of these claims is required.

Therefore, at least the following pending claims in Group I are readable on the provisionally elected species in Species Group I identified as mixed oxides (claim 2): claims 1-7, 10, 11, 13-28, 30, 31, 35-45, 47-48, 50-62, 67-70, 121-122, 127-133, 137-139, 141-153 and 160-180.

Additionally, at least the following pending claims in Group I are readable on the provisionally elected species in Species Group II identified as follows:

Linear and cyclic dextrins (claim 21): claims 1-31, 35-62, 67-70, 121, 122, 127-135, 137-139 and 141-183.

Gelatin (claim 23): claims 1-31, 35-62, 67-70, 121, 122, 127-135, 137-139 and 141-183.

Arginine (claim 26): claims 1-26, 28-31, 35-62, 67-70, 121, 122, 127-135, 137-139 and 141-183.

A. Claims 35 and 121 are Generic.

Applicant further respectfully submits that at least claims 35 and 121 are generic with respect to Species Group I. Claims 35 and 121 each recite a “rare earth compound” which can be any of the rare earth compounds recited in claim 2.

The Examiner is requested to note that under 37 CFR 1.41, a generic claim may link a reasonable number of species. See MPEP §809.02. Linking claims must be examined with the elected claims, and should the linking claim be allowed, rejoinder of the inventions must be permitted. MPEP §809.

RESPONSE TO RESTRICTION REQUIREMENT
Serial Number: 10758,972
Filing Date: January 16, 2004
Title: CORROSION RESISTANT COATINGS

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Barbara J. Clark, at 515-233-3865 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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Date August 22, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 22 day of August, 2005.

Name

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Signature

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